



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,800	03/29/2000	Steven M.H. Wallman	10392/46901	7334

7590 11/03/2003

Michael N Haynes  
Kenyon & Kenyon  
1500 K Street NW  
Washington, DC 20005

EXAMINER
----------

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 11/03/2003

#11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/537,800

Applicant(s)

WALLMAN, STEVEN M.H.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-177 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61, 65-130 and 134-177 is/are rejected.
- 7) ☒ Claim(s) 62-64 and 131-133 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Requirement for Information under 37 CFR 1.105

### **DETAILED ACTION**

1. This Non-Final Office action is responsive to Applicant's amendment filed August 13, 2003.

Claims 1, 8, 9, 48, 72, 110, 111, 117, 134, 140, 146, 153, and 160-177 have been amended. Please note that claim 140 is listed as "Original", but has been amended (as indicated by the inserted, underlined phrase "user preferences regarding" in line 5); therefore, claim 140 is constructively interpreted as "Currently Amended." Please label claim 140 accordingly in Applicant's response to the present Office action.

Claims 1-177 are pending.

2. The previously pending objections to the specification are withdrawn in response to Applicant's amendment of the specification.

The previously pending claim objections are withdrawn in response to Applicant's arguments and amendment of the claims.

The previously pending rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph are withdrawn in response to Applicant's amendment of the claims.

The previously pending rejection of claims 1-177 under 35 U.S.C. § 101 is withdrawn in response to Applicant's arguments.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-177 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-47, 72-116, 134-139, 146-152, and 160-177 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 1-47, 72-116, 134-139, 146-152, and 160-177 recite that some steps are “automatically” performed and some information is transmitted electronically, it is not clear whether or not the heart of the invention utilizes technology. For example, independent claims 1, 72, 134, 146, and 160 could reasonably be interpreted as being performed entirely by hand, where a human “automatically” (i.e., subsequently) votes in response to the receipt of voting preferences. It is respectfully suggested that Applicant explicitly recite that the receipt and processing of the votes is performed entirely by a computer system.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-27, 36-61, 65-103, 113-130, and 134-174 are rejected under 35 U.S.C. 103(a) as being unpatentable over ProxyEdge 2000 in view of Harnett (U.S. Patent No. 6,112,188).

As to claims 1, 48, 65, 72, 117, 134, 140, and 160, ProxyEdge 2000 teaches a computer system that collects electronic proxy cards in a computer to allow the user to make the desired selection of corporate actions through a computer. ProxyEdge 2000 clearly teaches that it was well known to one of ordinary skill in the art at the time of the invention that voting on corporate actions was moving into a computerized format, allowing distribution and collection of corporate votes electronically. ProxyEdge 2000 fails to teach that the votes are performed automatically based on user-set preferences.

Additionally, claims 146 and 153 recite communicating a corporate voting form to a shareholder and receiving the user's vote from a service that votes the user's shares. It is respectfully submitted that this claim is reciting the nature of a proxy vote. A proxy service basically collects the shareholder's proxy cards indicating the shareholder's votes and then actually makes the vote on behalf of the shareholder at the meeting. ADP is the proxy service that collects the shareholder's vote forms electronically through ProxyEdge 2000 and sends the vote to the actual proxy who will be making the vote according to the proxy vote forms. ProxyEdge 2000 teaches that the forms are communicated electronically as recited in claims 147-149 and 154-156.

As per claims 1, 11, 14, 23, 24, 26, 27, 36-48, 52-54, 57, 58, 60, 61, 65-67, 69-72, 82, 84, 85, 88, 96-98, 100, 102, 103, 113-117, 121, 123, 124, 127, 129, 134, 136, 140, 142, 146, 150, 151, 153, 157, 158, 160, 167, and 170-174, ProxyEdge 2000 fails to

teach that the votes are performed automatically based on user-set preferences; however, Harnett discloses an automated system in which an individual may delegate voting authority, which may include investment authority over part of a portfolio, to another organization (col. 9, lines 1-12; col. 16, lines 36-50; col. 42, lines 25-30). Hartnett's invention assists in simplifying the democratic voting process by allowing an individual to have his/her opinions reflected in a vote while minimizing the need to process a mass influx of votes from each individual regarding every issue put to a vote. Both ProxyEdge 2000 and Hartnett are directed toward a computerized voting system; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Hartnett's automated voting based on user-set preferences with ProxyEdge 2000's automated voting system in order to simplify the democratic voting process by allowing an individual to have his/her opinions reflected in a vote while minimizing the need to process an mass influx of votes from each individual regarding every issue put to a vote. Additionally, Hartnett teaches that votes are delegated to a financial institution; however, the same invention would be applicable to any type of organization with influence over a user for voting purposes. Therefore, the details of the types of organizations (i.e., affinity groups) recited in claims 39-47 do not patentably distinguish the claimed invention from the prior art.

Furthermore, since voting of corporate action taking is really old and well known and ProxyEdge 2000 teaches moving such activity into a computerized format, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used the well known technique of computer-based decision making based on

user-set preferences to automate what was otherwise a manual activity beginning to move onto a computerized format. Merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See MPEP §2144.04(III), citing *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

As to claims 2-5, 22, 49, 50, 57, 78-81, 99, 118, 119, 126, 163, 164, ProxyEdge 2000 already teaches an electronic voting form to be filled out by the user and sending the vote electronically to the corporation. Hence, the combination of ProxyEdge 2000 with automatic selections made by a computer based on user-set preferences as indicated above renders automatically making selections on an electronic voting form obvious and therefore unpatentable.

As to claims 6, 7, 68, 73, 75, 76, 161, 162, the ProxyEdge 2000-Hartnett combination would yield a computer automated system; therefore, the steps of receiving and storing the user's preferences in a database would be deemed inherent in such a combination. As to claims 10, 12, 13, 15, 87, 89, 90, 92, 122, 134, 135, 138-141, 144, 145, 168, Official Notice is taken that it is old and well-known in the art to provide voters with voting recommendations, such as a list of candidates endorsed by a particular organization. This assists voters in voting in accordance with organizations that they hold in high esteem, especially when the voters themselves do not feel well enough informed about the individual candidates. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with the ProxyEdge 2000-Hartnett combination the steps of providing recommendations on which the automated decision is based and then storing the

recommendations in order to assist voters in voting in accordance with organizations that they hold in high esteem, especially when the voters themselves do not feel well enough informed about the individual candidates.

As to claims 8, 9, 16-20, 51, 55, 56, 83, 86, 61, 93, 94, 95, 120, 165, 166, 169, Official Notice is taken that it is old and well-known in the art to provide a user with an interface to enter preferences, including from a list of available preferences. Such an interface facilitates quick and accurate entry of user preference data. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with the ProxyEdge 2000-Hartnett combination the use of an interface for a user to enter the preference data recited in the claims, including from a list of available preferences, in order to facilitate quick and accurate entry of user preference data.

Regarding claims 21, 25, 59, 101, 125, 128, 130, 137, 143, 152, and 159, the ProxyEdge 2000-Hartnett combination teaches the concept of automatically voting on behalf of a user by letting an affinity group cast the user's votes; however, the ProxyEdge 2000-Hartnett combination does not expressly teach that the user would vote against an identified affinity group. However, by voting in accordance with one affinity group's voting preferences, one is indirectly choosing to vote in opposition to all groups whose preferences differ from the chosen affinity group's preferences, thereby addressing the claimed invention.

As to claim 74, ProxyEdge 2000 teaches receiving a voting ballot, which would inherently describe the corporate actions on which the votes are to be based.

As to claim 77, Hartnett teaches collecting the preferences before the automated selection is made (col. 9, lines 1-12; col. 16, lines 36-50; col. 42, lines 25-30). It would have been obvious to one with ordinary skill in the art at the time of Applicant's invention that the preferences must be received before the automated action on which it would be based needs to be effectuated.

### ***Allowable Subject Matter***

8. Claims 28-35, 104-112, and 175-177 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 62-64 and 131-133 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Shaughnessy (U.S. Patent No. 6,484,151 B1) -- Discloses a portfolio management program host computer that automatically votes proxies of shares on behalf of a user.

11. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]


**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Application/Control Number: 09/537,800

Page 10

Art Unit: 3623

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
October 30, 2003

***37 CFR § 1.105 - Requirement for Information***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to identify products and services embodying the disclosed subject matter of U.S. Patent No. 6,601,044 B1, U.S. Patent No. 6,338,047 B1, and WO 99/46658 A2 (all of which have the same inventive entity and are assigned to the same assignee), and identify the properties of similar products and services found in the prior art. The Examiner is especially interested in the disclosed concept of specifying user preferences for investment purposes as well as for automatically voting on a user's behalf.

2. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

3. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

4. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three (3) months.

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
October 30, 2003

*Vincent Millin*

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600